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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,199	10/09/2003	Juha Kere	0933-0214P	9233

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action **Before the Filing of an Appeal Brief**

Application No.

10/681,199

Applicant(s)

KERE ET AL.

Examiner

Jeanine A. Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-9, 22, 23, 25 and 34.
Claim(s) withdrawn from consideration: 10-21, 24 and 26-33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Jeanine A. Goldberg
Examiner
Art Unit: 1634

Continuation of 3. NOTE: Claim 1 has been amended to require SEQ ID NO: 1 or the complement which simplifies the claim, however, Claims 2-5 remain dependant on Claim 1. Claims 2-5 no longer further limit Claim 1. New considerations would be required. Claims 6 remains drawn to a probe or primer which hybridizes to SEQ ID NO: 1. The description, enablement issues and art issues would remain appropriate. Claims 22 has been amended to require a compound which hybridizes.

Continuation of 11. does NOT place the application in condition for allowance because: The response that the Written Description Rejection is overcome by removal of the language from Claim 1. This argument has been reviewed but is not convincing because many of the claims remain drawn to hybridizing language including newly amended Claim 6 and 22.

The enablement does not specifically address Claim 9.

The response asserts the enablement does not specifically address 2-8, 23-25. This argument has been reviewed, but is not persuasive. Claims 4, 5 are directed to hybridization language which is specifically addressed.

The response asserts that Taipale reference is not available under 102 because it is applicants' own work. This argument has been reviewed but is not persuasive because there is a different inventive entity. It is noted that Taipale does not teach a nucleic acid of SEQ ID NO: 1. The response asserts that Claims 2-6 depend from Claim 1. This argument has been reviewed. Claim 6 does not depend on Claim 1 as argued by the response. Further, it is noted that in the newly amended Claims, Claims 2-6 do not appear to further limit Claim 1 and would be objected to as such.

The response asserts that NIH-MGC does not anticipate the claims, because Claim 1 has been amended. This argument has been reviewed but it is noted that Claims 2-8 no longer appear to further limit Claim 1. Claims 6 have been made an independent Claim and no longer depends on Claim 1 as argued by the response.

The response asserts that the ABS catalog does not anticipate the claims because the ABS catalog does not disclose all of claim 22. This argument has been reviewed but is not convincing. The ABS catalog teaches primers which hybridize to DYXC1 gene.

The response asserts that the newly amended Claim 22 is not obvious over Brennan in view of Ahern. The arguments are drawn to newly amended claims which are not entered. Thus the arguments are moot.